

REMARKS

The Examiner is thanked for the courtesy of a brief telephone interview on June 30, 2008 during which the undersigned requested that a final rejection of the claims was premature based on the course of prosecution, discussed the reasons therefore and requested withdrawal of the finality of the rejection. While the Examiner appeared to be persuaded by the argument, he stated that it should be presented in a formal submission so that it could be properly acted upon. The argument and reasoning are presented in detail hereinbelow for consideration by the Examiner.

Claims 1-3 and 5-43 are pending; claims 38-40 are allowed (as previously amended).

In an Office Action mailed June 5, 2008, the Examiner has taken the following actions responsive to Applicant's amendments and remarks mailed January 18, 2008:

1. Withdrawal of the rejection of claims 1, 5 and 41 under 35 U.S.C. §102(b) as anticipated by *Goodman et al.* (US 5,109,849);

2. Rejection of claims 1, 5 and 41 under 35 U.S.C. §103(a) over *Goodman et al.* (US 5,109,849) in view of *Meathrel et al.* (US 5,833,622);

3. Rejection of claims 6-10, 42 and 43 under 35 U.S.C. §102(e) as anticipated by *Schulze et al.* (US 7,223,239);

4. Rejection of claims 2 and 3 under 35 U.S.C. §103(a) over *Goodman et al.* (US 5,109,849) as applied to claim 1 and further in view of *Hirsch et al.* (US 5,345,935);

5. Rejection of claims 11 and 12 under 35 U.S.C. §103(a) over *Schulze et al.* (US 7,223,239) as applied to

claim 10 and further in view of *Dempsey et al.* (US 5,417,222); and

6. Rejection of claim 37 under 35 U.S.C. §103(a) over *Goodman et al.* (US 5,109,849) and *Meathrel et al.* (US 5,833,622) as applied to claim 1 and further in view of *Schulze et al.* (US 7,223,239).

Furthermore, it is important to note that Applicant amended claim 1 in its submission on January 18, 2008 only by incorporating subject matter already present in the claim, albeit in the claim preamble, into the body of the claim in order to emphasize its arguments that the language was indeed part of the claimed invention and not to be disregarded as having no patentable weight. For convenience, amended claim 1 is shown below in tracked format:

"1. ~~An apparatus for determining the condition of a region of tissue comprising:~~

- (A) a cup having an interior, and first and second openings;
- (B) a current-passing electrode disposed within the interior; and
- (C) a source of suction connectable to the first opening; and

wherein when the second opening is placed over a region of tissue, an electroconductive medium is disposed within the interior for facilitating an electrical connection between the region of tissue to be examined and the electrode and suction is applied to the first opening, an electrical connection is made between the region of tissue to be examined and the electrode via the electroconductive medium and wherein said apparatus is suitable for determining the condition of a region of tissue.

Since claim 1 was substantively unchanged from the application as originally filed, the amendment cannot reasonably be said to have been the cause for a new search or rejection of claim 1 under a different portion of the Patent Statute relying on a combination of references not previously presented. By

declaring that the rejection is "final" the Examiner has deprived Applicant of his right to address this new rejection as a matter of right.

Applicant respectfully requests that the finality of the rejection of the claims be reconsidered and withdrawn.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 9, 2008

Respectfully submitted,

By 

Harvey L. Cohen

Registration No.: 28,365

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicant

LD-447\